

REMARKS

Claims 88-27 and 64-77 are pending in the application. Claims 8, 64, 65, 67, 72-73 are amended. Claims 74 and 75 are canceled. Applicants thank the Examiner for the allowance of Claims 70, 71 and 77.

35 USC §112 Rejection

Claims 72-75 stand rejected under 35 USC §112, first paragraph, as failing to comply with the written description requirement. The Examiner states that the term “substantially free” in Claims 72 and 73 is not mentioned in the disclosure as originally filed. Claims 72 and 73 have been amended to remove the term “substantially”. The Examiner states that Claims 74 and 75, which recite that the oligo/resin component is a di-functional moiety, are not supported because the specification discloses only that the oligo/resin can be a di(meth)acrylate of an aliphatic urethane. Claims 74 and 75 have been canceled and the rejection is rendered moot.

Claims 65, 67 and 72-75 stand rejected under 35 USC §112, second paragraph as being indefinite. Claims 65, 67, 72 and 73 have been amended to remove the term “substantially”. Claims 74 and 75 have been canceled and the rejection is rendered moot.

35 USC § 103(a) Rejection

Claims 8-25, 64-68 and 76 stand rejected under 35 USC § 103(a) as being unpatentable over WO 99/29787. Applicant respectfully submits that a *prima facie* case of obviousness has not been established because, at the very least, the reference does not teach or suggest all of the claim limitations of independent claims 8 and 64.

Claims 8 and 64 now recite that the ink jettable fluid composition has **less than 10 weight percent of alkoxyolated monomers comprising main-chain alkoxyolated functionality.**

The Examiner states that WO '787 discloses using 10-30 weight percent tri- or higher functional main chain alkoxyolated acrylate monomers. The Examiner then states that a claim of less than 10 weight percent is disclosed because a disclosure of 10-30 weight percent encompasses 9-31 weight percent when significant figures are taken into consideration, and therefore overlaps the

claimed range. Additionally, WO '787 teaches to use lower viscosity compounds, so it is within the disclosure to use 10 weight percent when using a high viscosity monomer.

However, the reference must be read as a whole. WO '787 teaches that if the total amount of these tri- or higher functional material in the ink is less than 10 % by weight, the properties of the print obtained from the ink, and in particular hardness and scratch resistance, may tend to suffer (see page 16 of WO '787). In making the statement that the disclosure in WO '878 of 10-30 weight percent would encompass 9 weight percent, the Examiner is ignoring the express teaching in the reference that would negate that very position.

The Examiner goes on to state, that, while WO '787 may teach a disadvantage below 10%, it teaches that the 10-30 weight percent may be achieved with a blend of oligomers, so one of skill in the art is taught that one of the oligomers may be present in less than 10 weight percent. Applicant has amended Claims 8 and 64 to clarify for the Examiner that the fluid comprises less than 10 weight percent of alkoxyated, radiation curable monomers comprising main-chain alkoxyated functionality. The amendment is supported by paragraph 55 of published application US2002/0086914.

Thus, Applicants assert that the *prima facie* case of obviousness has not been established since the cited reference does not disclose all the elements of the independent claims. Reconsideration is respectfully requested.

Double Patenting

Claims 8-27 and 64 stand rejected under the judicially created doctrine of double patenting. Applicant respectfully defers response to this rejection given the amendments to the claims.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

Respectfully submitted,

Date

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